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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,984	08/22/2001	Stuart Leon Soled	GJH-0005	4480

7590 12/17/2004
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EXAMINER
HAILEY, PATRICIA L

ART UNIT	PAPER NUMBER
1755	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,984

Applicant(s)

SOLED ET AL.

Examiner

Patricia L. Hailey

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date February 5, 2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Specification

Applicants are respectfully requested to update the "Cross-Reference to Related Applications" on page 1 of the Specification. While reference to the parent applications has been provided, the status of these applications (e.g., "now U. S. Patent No. 1,234,567) is not present.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. *Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.*

The claims are indefinite because, while drawn to a process for hydroprocessing a petroleum feedstock, do not sufficiently recite any process limitations (e.g., temperature, pressure, LHSV, etc.) defining the claimed process. The word "contacting", which is recited in claim 1, alludes to any of a variety of known process parameters; such a word does not clearly set forth the metes and bounds of patent protection desired.

Claim 4 is indefinite because there is no numerical value or range for the variable "z", nor is there a mathematical formula. See, for example, Applicants' Specification at page 7, line 2.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. ***Claim 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7, and 8 of U.S. Patent No. 6,162,350.***

Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant claims and the patented claim are

directed to a process for hydroprocessing a petroleum feedstock. However, the instant claims disclose a catalyst employed in the process that comprises at least one Group VIII non-noble metal (Ni, Co) and at least one Group VIB metal (Mo, W), wherein the ratio of Group VIB metal to Group VIII non-noble metal is from about 10:1 to about 1:10; see Applicants' claim 1. The Patented Claim recites a catalyst composition comprising a nickel species of nickel molybdate in which a portion but less than all of molybdenum is replaced by tungsten, said species having the formula $(\text{Ni})_b(\text{Mo})_c(\text{W})_d\text{O}_z$.

This species is almost the same as the formula recited in Applicants' claim 4: $(\text{X})_b(\text{Mo})_c(\text{W})_d\text{O}_z$, where X is defined as a Group VIII non-noble metal, e.g., Ni (see Applicants' claims 2 and 3). Further, the ranges/values for the variables b, c, and d in instant claims 4-6 are the same as, if not overlapping, those respectively recited in Patent Claim 1.

Instant claim 7 and Patent Claim 7 are identical with respect to the X-ray diffraction pattern and the crystalline peaks shown.

The term "distillate" in Patent Claim 8 is considered to read upon the limitations of Instant Claim 8.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

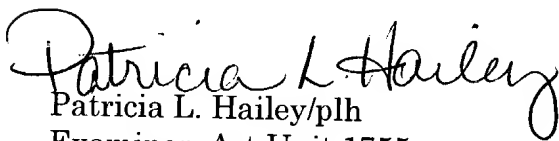
Ferlazzo et al. (U. S. Patent No. 4,014,925) and Velenyi (U. S. Patent No. 4,808,563) elementally teach the catalyst recited in the instant claims, i.e., teach the same components (Ni, Mo, W, etc.). However, these references teach ranges of these components that are not commensurate with those recited in the instant claims. Also, Ferlazzo et al. disclose a process for the production of methyl acrylate of a mixture of methyl acrylate with acrylic acid, and Velenyi disclose a method for the conversion of methane to higher order hydrocarbons.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Hailey whose telephone number is (571) 272-1369. The examiner can normally be reached on Mondays-Thursdays.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on (571) 272-1362. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group 1700 Receptionist, whose telephone number is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patricia L. Hailey/plh
Examiner, Art Unit 1755
December 10, 2004


Mark L. Bell
Supervisory Patent Examiner
Technology Center 1700